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REMARKS

Claims 1 – 23 are in the application. Reconsideration is respectfully requested.

Claim Rejections Under 35 USC §102

Claims 1-8, 17, 18 and 20-23

These claims were rejected as anticipated by Fowler, US Patent No. 5,962,861. On page 2 of the Detailed Action, the Examiner points to the Fowler registration roller 56 and asserts that the roller deflects away from a print medium drive mechanism as the print medium passes between the roller 56 and the drive mechanism. A portion of Fowler (Column 4, lines 13 –17) was identified as apparently supporting this function.

In reply, applicant notes that there is nothing in Fowler to indicate that the pinch roller 56 deflects in any way as print medium passes. The identified portion of Fowler notes that the *paper* deflects, and that this deflection occurs downstream of the roller. Accordingly, Fowler fails to teach the roller deflection of claim 1. Fowler also fails to teach deflection of a component of the print medium transport mechanism (which mechanism advances print medium through the printzone) as recited in claim 17. Similarly, the limitation recited in claim 22: “*deflection of a component of the means for advancing [the print medium] as the print medium passed therethrough*” is not found in Fowler.

The MPEP makes it clear that “*to anticipate a claim, the reference must teach every element of the claim.*” (MPEP § 2131). Quoting Federal Circuit Court opinions, the MPEP continues:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In view of the foregoing explanation of how Fowler fails to disclose at least one element of claims 1, 17 and 22, the rejection of those claims, and the claims depending therefrom, should be withdrawn.

The office action points out that the Fowler sensor 61 measures the deflection of the paper. The Examiner then concludes that this measure is “*obviously also the deflection of [the] pinch roller mechanism*” as relates to claims 1, 17, and 22. In response, applicant notes that, as

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discussed above, there is no teaching in Fowler relating to a pinch roller that deflects when paper passes.

Even if such a structure existed in Fowler, applicant strongly disagrees that the Fowler measurement of the deflection of paper at a location downstream of the pinch roller inherently¹ measures the deflection of a pinch roller mechanism. In this regard, applicant notes that there is no factual or technical reasoning present in the office action to support the conclusion that Fowler inherently measures deflection of something other than the lever 62 that is downstream of the pinch roller 56. Accordingly, the foregoing conclusion that Fowler inherently teaches such measure should be withdrawn.

It is noteworthy that Fowler's method, which is concerned with detecting paper *strength* and not necessarily paper *thickness*, contemplates a sensor that, in some situations, will not deflect when paper² is moved past it. Thus, a measure of the paper strength (i.e., lightweight) is made without the deflection of anything in Fowler. This is because, unlike the apparatus of claim 1 wherein the deflectable roller member is biased against a drive mechanism and the paper moves between that roller and mechanism, the Fowler lever is not biased against such a mechanism. Thus, in some situations the Fowler sensor lever simply does not move. Therefore, Fowler also fails to disclose the structure and function of the claimed deflectable roller member, which is biased against a drive mechanism, and that deflects away from the drive mechanism when paper passes between the roller mechanism and the drive mechanism.

Claim Rejections Under 35 USC §103

Claims 9-16 and 19

These claims were rejected as obvious in view of the combination of Fowler and Rasmussen, US Patent No. 6,179,419. For the following reasons, applicant submits that a proper *prima facie* case of obviousness has not been made with respect to these claims, and this rejection should be withdrawn.

The MPEP, in § 2143, sets forth what is needed for establishing a *prima facie* case of obviousness for rejecting claims under 35 USC § 103. The pertinent portion of that section is reproduced here:

¹ Although the Examiner expressed the assertion that Fowler measures roller deflection as "*obviously* ..." in the context of a rejection under Section 102, applicant believes the Examiner intended to characterize the conclusion as *inherently* flowing from Fowler.

² In this situation, lightweight paper.

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"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Applicant submits that at least one of the criteria set forth above has not been met in the present office action.

The office action points out that Fowler fails to show a shim that is biased against the print medium drive mechanism and configured to deflect away from the print medium drive mechanism as the print medium passes between the shim and print medium drive mechanism. The office action states that Rasmussen shows this. Guide shim 46 of Rasmussen's Fig. 1, and the text appearing in column 4, lines 10 – 12 of Rasmussen, are identified as the places where this limitation is disclosed.

In response, applicant notes that the parts of Rasmussen identified in the office action only disclose that the guide shim *deflects* the media transport belt 32 and media sheet 16. Rasmussen does *not*, however, teach or suggest the guide shim being *deflected*, as is claimed. Accordingly, and with reference to the above-quoted portion of the MPEP, the combination of prior art references made in the office action does not teach or suggest all of the claim limitations. As such, a *prima facie* case of obviousness has not been made, and the rejection of claims 9 – 16 and 19 should be withdrawn.

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Conclusion

In view of the foregoing, applicant submits that all of the pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, s/he is invited to contact applicant's attorney at the below-listed telephone number.

Respectfully submitted,
ipsolon llp

By 

Patrick W. Hughey
Registration No. 31,169
Tel. No. (503) 419-0704

Please address all correspondence to:

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400